

REMARKS

In an office action dated 10 February 2004, the Examiner rejects claims 1-8 (all pending claims). In response to the Office Action, Applicants respectfully traverse the rejection. Claims 1-8 (all pending claims) remain in the Application. In light of the following arguments, Applicants respectfully request that claims 1-8 and the Application be allowed.

In the office action, the Examiner rejects claim 1 as being unpatenable under 35 U.S.C. §103(a) over U.S. Patent Number 6,052,687 issued to Miura et al (Miura) in view of U.S. Patent Number 6,052,687 issued to Lindsay et al (Lindsay). In order to maintain a rejection the Examiner has the burden of providing evidence of prima facie obviousness. See MPEP §2143. See also In Re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to prove prima facie obviousness, the Examiner must provide evidence in the prior art of a motivation to combine or modify a reference, a reasonable expectation of success, and a teaching of each and every claimed element. *Id.* The Examiner has failed to provide a teaching of each and every element of the claims and a proper motivation to combine the references.

Claim 1 recites "(b) marking instances of tables of said input list having single occurrences in an heirarchial representation of a database schema, and marking ancestors of said instances of table according to said heirarchial representation." The Examiner admits in the office action that Lindsay does not teach this limitation. Applicants respectfully traverse the Examiner's assertion that Miura teaches this limitation. The Miura reference teaches generating tables showing the links between tables in a relational database. When a table has no fields in common with another table. A "nodirect link" entry is put in an intermediate link table. See Col. 7, lines 57-61. The Miura reference catalogs the links between tables and does not show the path in a hierarchal representation of a relational database. Miura merely describes a method for making the links between various tables and does not show a method for marking each and every table needed to generate a join graph. The Miura reference shows the paths needed to access information and does not provide a method for marking particular tables for generating a join graph. The essential difference is that Miura describes the links between tables and does not mark the tables needed to make a graph as recited in

claim 1. The cited part of the Miura reference merely talks about determining the links between tables and does not mention marking a single occurrence table and all ancestors of the table as recited in amended claim 1. Thus, this element is not taught by Miura or Lindsay and the rejection must be removed.

Claim 1 also recites "(c) marking unmarked instances of multidimensional tables of said input list closest to marked instances, marking unmarked ancestors of said unmarked instances of said multi-dimensional tables according to said hierarchical representation, and marking unmarked instances of one-dimensional tables that reference said multidimensional tables and have said unmarked instances of said multi-dimensional tables as parents according to said hierarchical representation." The Examiner admits in the office action that Lindsay does not teach this limitation. Applicants respectfully traverse the Examiner's assertion that Miura teach this limitation. The Miura reference teaches generating tables showing the links between tables in a relational database. Miura teaches a process that generates a table showing the links between tables. Miura does not mark a multidimensional table and marking of one dimensional tables that reference the multi-dimensional table. Miura merely describes a method for making the links between various tables and does not show a method for marking each and every table needed to generate a join graph. The Miura reference shows the paths needed to access information and does not provide a method for marking particular tables for generating a join graph. The essential difference is that Miura describes the links between tables and does not mark the tables needed to make a graph as recited in claim 1. The cited part of the Miura reference merely talks about determining the links between tables and does not mention marking a single occurrence table and all ancestors of the table as recited in amended claim 1. Thus, this element is not taught by Miura or Lindsay and the rejection must be removed.

Claim 1 also recites "(d) marking unmarked ancestors of one-dimensional tables of said list of tables closest to marked instance, marking unmarked ancestors of said unmarked instances of said one-dimensional tables according to said hierarchical representation." The Examiner admits in the office action that Lindsay does not teach this limitation. Applicants respectfully traverse the Examiner's assertion that Miura teaches this limitation. The Miura reference teaches generating tables showing the links between tables in a relational database. When a table has no fields in common with

another table. A "nodirect link" entry is put in an intermediate link table. See Col. 7, lines 57-61. Miura goes on to teach how links are determined for tables having common entries. The Miura reference catalogs the links between tables and does not show the path in a hierarchal representation of a relational database. Miura merely describes a method for making the links between various tables and does not show a method for marking each and every table needed to generate a join graph. The Miura reference shows the paths needed to access information and does not provide a method for marking particular tables for generating a join graph. The essential difference is that Miura describes the links between tables and does not mark the tables needed to make a graph as recited in claim 1. The cited part of the Miura reference merely talks about determining the links between tables and does not mention marking a single occurrence table and all ancestors of the table as recited in amended claim 1. Thus, this element is not taught by Miura or Lindsay and the rejection must be removed.

Since neither Lindsay nor Miura teaches these limitations, the combination of these references does not teach these limitations. Thus, the rejection cannot be maintained.

Furthermore, even if the Miura teaches all of the cited limitations, the Examiner has not provided a proper motivation to combine. Case law and the MPEP require that the motivation combined be found in the prior art or in the general knowledge of those skilled in the art. See MPEP §2143.01. See also In re Kotzab, 217 F3d 1365 (Fed. Cir 2000). The Examiner has not shown anywhere in the cited reference that presents the motivation asserted. If the Examiner is relying on general knowledge in the art, Applicants challenge this assertion and request a chance to respond to such evidence as is required in MPEP §2144.03. If no evidence is provided this rejection cannot be maintained and Applicants respectfully request that claim 1 be allowed.

Claim 2-8 are dependent upon claim 1. Therefore, claims 2-8 are allowable for at least the same reasons as claim 1. Thus, Applicants respectfully request that the rejections of claims 2-8 be removed and claims 2-8 be allowed.

If the Examiner has any questions regarding this response or the Application in general. The Examiner is invited to telephone the undersigned at 775-586-9500.

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Respectfully submitted,
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